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OFFICE OF PETITIONS

In re Application of :
Chang and Platt :
Application No. 10/657383 : ON PETITION
Filed: 09/08/2003 :
Atty Dckt No. GLYO-P03-002 :

This is a decision in reference to the renewed petition filed on 1 October, 2007, which is treated as (a) a petition under 37 CFR 1.48(a)(1) requesting a person be deleted as a named inventor; (b) a petition under 37 CFR 1.47(a) and 37 CFR 1.183(a)(1) requesting waiver of 1.48(a)(1) in that a person sought to be added as a named inventor will not sign the statement of lack of deceptive intent or the declaration under 37 CFR 1.63 and 1.67; and (c) a petition under 37 CFR 1.183 requesting waiver of 37 CFR 1.64 which requires that a named inventor execute a supplemental declaration.

The petition is **GRANTED**.

On 8 September, 2003, the above-identified application was filed with a declaration naming Yan Chang and Vodek Sasak as joint inventors.

On 25 May, 2007, the initial petitions were filed. Petitioners request that Vodek Sasak be deleted and David Platt be added as named inventors under 37 CFR 1.48(a)(1). Petitioners further request waiver under 37 CFR 1.183 of 1.48(a)(1) in as much as Platt refuses to sign the statement of lack of deceptive intent and the declaration under 37 CFR 1.63. A petition under 37 CFR 1.47(b) is requested in that the inventor sought to be added, as well as the existing inventor, refuse to the declaration under 37 CFR 1.63. Lastly, petitioners also request waiver under 37 CFR 1.183 of 1.64 in that a named inventor, Yan Chang, refuses to execute the supplemental declaration naming him as a joint inventor along with David Platt. On 1 August, 2007, the petition was dismissed for lack of a proper oath or declaration.

On 1 October, 2007, the present renewed petition was filed, accompanied by a declaration naming Yan Chang and David Platt as joint inventors, signed on behalf of inventors Chang and Platt by Joseph Grimm, President of assignee of record Prospect Therapeutics, Inc.

Petition Under 37 CFR 1.48(a) and Under 37 CFR 1.183 to Waive 1.48(a).

37 CFR 1.48(a) requires that an amendment to the named inventive entity be accompanied by:

(1) a petition including a statement from each person being added and each person being deleted as an inventor that the error occurred without deceptive intention on his or her part;

(2) an oath or declaration by each actual inventor or inventors as required by 37 CFR 1.63 or as permitted by 37 CFR 1.42, 1.43 or 1.47;

(3) the fee set forth in 37 CFR 1.17(i), and

(4) the written consent of any existing assignee, if any of the originally named inventors has executed an assignment.

Petitioners have provided a statement of lack of deceptive intent signed by Sasak, filed 30 April, 2007, as well as, with the renewed petition, an oath or declaration by each actual inventor or inventors as required by 37 CFR 1.63 or as permitted by 37 CFR 1.42, 1.43 or 1.47. Additionally, the required fee, and the written consent of the assignee, were provided with the original petition.

As such, the petition under 37 CFR 1.48 is granted with respect to the deletion of Vodak Sasak as a named inventor.

With regard to joint inventor David Platt, petitioners have shown that a letter was sent to Platt's attorney, asking for Platt's signature on the statement of lack of deceptive intent and on the declaration under 37 CFR 1.63 and 1.67, but that Platt's attorney Barry Schindler of the law firm Greenberg Traurig sent back a letter, dated 18 May, 2007, stating that Platt would not sign the statement of lack of deceptive intent or the declaration under 37 CFR 1.63 and 1.67.

Petitioners have also provided statements of consent of the assignee to the deletion of Vodak Sasak and the addition of David Platt as inventors.

Petitioners have provided, with the renewed petition, an oath or declaration by each actual inventor or inventors as required by 37 CFR 1.63 or as permitted by 37 CFR 1.42, 1.43 or 1.47;

In view of the efforts recounted in the petition to obtain the signature of David Platt, it is agreed that justice would be served by waiving the requirement for his signature on the statement of lack of deceptive intent.

As such, the petition under 37 CFR 1.183 to waive 1.48 is granted with respect to the addition of David Platt as a named inventor.

Petition Under 37 CFR 1.47(a).

With regard to David Platt's refusal to sign the declaration under 37 CFR 1.63 and 1.67, as joint inventors Sasak and Chang signed the original declaration filed on 8 September, 2003, at least one inventor (Yang) was available to sign the declaration.

As such, a petition under 37 CFR 1.47(b) is not appropriate.¹ Rather, a petition under 37 CFR 1.47(a) is required with regard to Platt's refusal to sign the declaration under 37 CFR 1.63 and 1.67. Nevertheless, as no inventors are available to sign the declaration naming the actual inventors, an oath or declaration signed by an appropriate party on behalf of the non-signing and signing inventors is required.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee;
- (4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and
- (5) a statement of the last known address of the non-signing inventor.

¹ Filing under 37 CFR 1.47(b) and 35 U.S.C. 118 is permitted only when no inventor is available to make application. MPEP 409.03(b).

Petitioners have shown that the non-signing inventor, David Platt, has refused to join in the filing of the above-identified application after having been sent a copy of the application papers. Specifically, the petitioners have established that a copy of the application was sent to the non-signing inventor via his counsel. The non-signing inventor, however, has failed to return an executed declaration naming him as a joint inventor along with Yan Chang.

The above-identified application and papers have been reviewed and found in compliance with 37 CFR 1.47(a). This application is hereby accorded Rule 1.47(a) status.

As provided in Rule 1.47(c), this Office will forward notice of this application's filing to the non-signing inventor at the address given in the declaration. Notice of the filing of this application will also be published in the Official Gazette.

Petition Under 37 CFR 1.183 to waive 1.64.

Petitioners lastly assert that inventor Yan Chang has refused to sign the declaration naming him and David Platt as joint inventors.

There is no requirement for a showing under 37 CFR 1.47 with regard to joint inventor Chang, as noted above. This application bears an original Declaration executed by joint inventor Chang, and thus, the provisions of 37 CFR 1.47 do not apply with regard to Chang's signature. Nevertheless, it is appropriate to apply the principles thereof to the situation at hand.

In view of the efforts recounted in the petition to obtain the signature of Yan Chang, it is agreed that justice would be served by waiving the requirement for his signature on the supplemental declaration filed on 1 October, 2007.

The inventorship will be as stated in the attached corrected filing receipt.

The application is referred to Technology Center Art Unit 1623 for further processing.

Telephone inquiries related to this decision should be directed to the undersigned at 571-272-3231.



Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

Encl: Corrected Filing Receipt



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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| APPLICATION NUMBER | FILING or, 371(c) DATE | GRP ART UNIT | FIL FEE REC'D | ATTY. DOCKET NO | TOT CLAIMS | IND CLAIMS |
|-----------------------|---------------------------|-----------------|---------------|-----------------|------------|------------|
| 10/657,383 | 09/08/2003 | 1623 | 481 | GLYO-P03-002 | 22 | 1 |

CONFIRMATION NO. 9375

CORRECTED FILING RECEIPT



28120
ROPES & GRAY LLP
PATENT DOCKETING 39/41
ONE INTERNATIONAL PLACE
BOSTON, MA 02110-2624

Date Mailed: 11/07/2007

Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Filing Receipt Corrections. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections**

Applicant(s)

Yan Chang, Ashland, MA;
David Platt, Newton Center, MA;

Assignment For Published Patent Application

GlycoGenesys, Inc., Boston, MA

Power of Attorney: The patent practitioners associated with Customer Number 28120

Domestic Priority data as claimed by applicant

This application is a CON of 10/176,235 06/20/2002 PAT 6,680,306
which claims benefit of 60/299,991 06/21/2001

Foreign Applications

If Required, Foreign Filing License Granted: 11/26/2003

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 10/657,383**

Projected Publication Date: Not Applicable

Non-Publication Request: No

Early Publication Request: No

**** SMALL ENTITY ****

Title

Method for enhancing the effectiveness of cancer therapies

Preliminary Class

514

PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at <http://www.uspto.gov/web/offices/pac/doc/general/index.html>.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, <http://www.stopfakes.gov>. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

LICENSE FOR FOREIGN FILING UNDER

Title 35, United States Code, Section 184

Title 37, Code of Federal Regulations, 5.11 & 5.15

GRANTED

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as

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The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

NOT GRANTED

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).



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David Platt
12 Appleton Circle
Newton Center MA 02459

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OFFICE OF PETITIONS


In re Application of
Chang et al.
Application No. 10/657,383
Filed: September 8, 2003
For: METHOD FOR ENHANCING THE EFFECTIVENESS OF CANCER THERAPIES

Dear Dr. Platt:

You are named as a joint inventor in the above identified United States patent application, filed under the provisions of 35 U.S.C. 116 (United States Code), and 37 CFR 1.47(a), Rules of Practice in Patent Cases. Should a patent be granted on the application you will be designated therein as a joint inventor.

As a named inventor you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent attorney or agent presenting written authorization from you. If you care to join the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Telephone inquiries regarding this communication should be directed to the undersigned at 571/272-3231. Requests for information regarding your application should be directed to the File Information Unit at 571-272-3150. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to Certification Division at 571-272-3150 or 1-800-972-6382 (outside the Washington D.C. area).


Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

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